

REMARKS

With reference to the Final Office Action, dated September 11, 2008, mentioned above, in which: claims 1-9, 11-16, and 18-40 are rejected under 35 USC 102 on US Patent No. 6,339,767 (hereinafter, Rivette); and claims 10 and 17 are rejected under 35 USC 103 on Rivette in view of "Aesthetics-Based Graph Layout for Human Consumption" (hereinafter, Coleman), Assignee respectfully requests reconsideration of the present patent application in light of the foregoing amendments and the following remarks. It is asserted that the claims are in condition for allowance and favorable action in this regard is respectfully requested.

Claims 1-40 are pending. Claims 1, 11, 24, 31, 35 and 39 are amended. No claims have been withdrawn or cancelled and no new claims have been added.

Priority Claim

Assignee notes the Examiner's statement regarding priority. Assignee filed a petition with the petitions office so that appropriate priority may be recognized in the present application. On December 8, 2008, a Decision on Petition under 37 CFR §§ 1.78(a)(3) and (a)(6) was granted to accept an unintentionally delayed claim under 35 USC §§ 120 and 119(e) for the benefit of priority to the prior filed application 09/454,457.

Additionally, on December 15, 2008, a Decision on Petition under 37 CFR §§ 1.137(b) was dismissed as moot as the Office of Petitions determined that revival of application serial number 09/454,457 was not necessary in order to amend the application to add the priority claim. Accordingly, the Office of Petitions entered the amendment adding the priority claim in application serial number 09/454,457.

It is the Assignee's understanding from the December 8, 2008, Decision on Petition under 37 CFR §§ 1.78(a)(3) and (a)(6) that the Examiner will now consider the benefit claim in the present application to determine whether the present application is entitled to the earlier filing date.

Claim rejections – 35 USC §102

The Examiner has rejected claims 1-9, 11-16, and 18-40 are rejected under 35 USC §102 on Rivette. This rejection by the Examiner of these claims on this ground is respectfully traversed. Assignee notes that claims 1, 11 and 24 have been amended.

The Examiner is reminded that the Manual of Patent Examining Procedure ("MPEP"), in § 2131, states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
Verdegaal Bros. V. Union Oil Co. California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Thus, under 35 USC § 102, a claim is anticipated *only if* each and every element of the claim is found in the cited document.

We begin with claim 1, as amended. The Examiner has correctly pointed out that aspects of Assignee's previous argument are not necessarily reflected in the language of the pending claims. Therefore, the foregoing amendment is intended to clarify the language so that the claims do reflect such aspects. Assignee therefore respectfully asserts that the claims as amended now patentably distinguish from Rivette. More specifically, amended claim 1 recites:

1. (Currently Amended) *A method of searching a database of data elements, the method comprising: based on a starting data element, identifying a first set of one or more data elements in the database, the data elements of the first set being referenced by the starting data element, based on the first set, identifying a second set of one or more data elements in the database, the data elements of the second set referencing one or more of the data elements of the first set, and generating data based on the data elements of the first and second sets and the relationships therebetween;*
the second set being identified by any number of recursive searches in which any successive search in comparison with the immediately preceding search is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention.

At page 25 of the September 11, 2008, Office Action the Examiner indicated that the Assignee's previous arguments were not necessarily reflected in the language of the pending claims as follows:

For instance, the claim language clearly does not require that an infinite number of recursive searches be performed; it merely requires that any successive searches, *if executed*, be capable of either being contracted, expanded or modified to include one or more generations of interrelated data elements.

In response, Assignee has amended claim 1 to now recite "the second set being identified by any number of recursive searches in which any successive search in comparison with the immediately preceding search is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements". Accordingly, Assignee respectfully submits that amended claim 1 encompasses an innumerable number of recursive searches, in which any successive search, in comparison with the immediately preceding search, is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated elements. Second, at pages 25-26 of the September 11, 2008, Office Action the Examiner indicated that the Assignee's previous arguments were not necessarily reflected in the language of the pending claims as follows:

Furthermore, contrary to the Applicants' arguments, the placement of the 'without user interaction' clause indicates that it applies only to the identification of the second set, but not necessarily to any successive searches which may or may not be executed.

In response, Assignee has amended claim 1 to now recite "the second set being identified by any number of recursive searches in which any successive search in comparison with the immediately preceding search is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention". Accordingly, Assignee respectfully submits that amended claim 1 encompasses an innumerable number of recursive searches, in which any successive search, in comparison with the immediately preceding search, is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated elements, all of which occurs without any human intervention. In contrast, at page 6 of the September 11, 2008, Office Action the Examiner has noted that Rivette discloses operator intervention as follows:

...(see disclosure that the patent citation report can be performed and displayed in a recursive fashion with an operator specified depth.

In view of the Examiner's admission that Rivette discloses operator intervention, Assignee respectfully submits that the Examiner has not established that Rivette discloses "without any human intervention" as recited in amended claim 1. Accordingly, it is respectfully requested that the rejection of amended claim 1 under 35 USC §102(b) be withdrawn.

Likewise, claims 2-9, 12-16, 18-40 depend from the amended claims and, therefore, also patentably distinguish from Rivette on at least the same or similar basis. It is therefore respectfully requested that the Examiner withdraw the rejection of these claims.

Claim rejections – 35 USC §103

The Examiner has also rejected claims 10 and 17 under 35 USC §103 on Rivette in view of Coleman. This rejection of these claims on this ground is respectfully traversed.

It is noted that claims 10 and 17 depend from claims discussed above that have been distinguished from Rivette. It is respectfully asserted that Coleman fails to cure the deficiency of Rivette with respect to the base claims. Therefore, without conceding that the combination proposed is proper, whether Rivette and Coleman are viewed together or individually, claims 10 and 17 patentably distinguish from the applied documents at least for the reasons discussed above. Assignee therefore respectfully requests that the Examiner withdraw his rejection of these claims.

For at least the reasons listed above, Assignee respectfully submits that claims 1-40 are allowable. Failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. It is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3130.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,

BERKELEY LAW AND TECHNOLOGY GROUP, LLP

Dated: January 8, 2009

/James J. Lynch Reg. No. 50,153/

James J. Lynch
Reg. No. 50,153

Customer No. 43831
c/o Berkeley Law & Technology Group, LLP
17933 NW Evergreen Parkway, Suite 250
Beaverton, OR 97006
503.439.6500 (office)
503.439.6558 (fax)

cc: Docketing